

Remarks

Applicants appreciate the recognition of patentable subject matter (i.e., previously pending claim 28) in the present application. Applicants wish to thank the Examiner for the courtesies extended to the undersigned during the telephone interview. An interview summary accompanies this response.

Applicants hereby add new claims 35-43 and cancel claim 28. Accordingly, claims 1-15, 22-23, and 26-27, 29-43 are pending in the present application.

Claims 1-15, 22-23, 26-27, 29-31 and 33-34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 2002/0018124 A1 Mottur et al. in view of U.S. Patent No. 6,172,672 Ramasubramanian et al. Claim 32 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Mottur and Ramasubramanian in further view of U.S. Patent No. 6,591,068 to Dietz.

Applicants respectfully traverse the rejections and request allowance of all pending claims.

Referring to claim 1, Applicant has amended the method to include limitations of previously pending claim 28 indicated by the Office to recite allowable subject matter. Claim 1 is believed to be in immediate condition for allowance in view of the indicated allowability of claim 28.

The claims which depend from claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 11, Ramasubramanian teaches the provision of photographs of frames of a previously generated video stored as a video file 104 as set forth in col. 3, lines 50+. The apparatus of claim 11 recites one or more photo-video acquisition devices capable of acquiring videos and high resolution photographs and wherein the devices are remote video cameras configured to acquire the videos and photographs of a live scene as originally viewed in real time for the first time by the remote video cameras. The prior art disclosing photographs of a video file is void of disclosing or suggesting the remote video camera in combination with the other limitations of claim 11 including acquiring high resolution photographs and claim 11 is allowable for at least this reason.

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The claims which depend from claim 11 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 26, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 2).

Applicant again reiterates the position there is no proper motivation to combine the reference teachings for the reasons set forth in the previous response and the rejection is improper for at least this reason. In addition with respect to lack of motivation, the Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

Applicant states there is no motivation for the following additional reasons. More specifically, the rationale provided by the Office for combining the references is at page 3 of the Action so that a user can obtain a snapshot having a size and

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quality that is superior to the low-resolution video image and at page 5 of the Action that it is preferable to include a snapshot function because often users like to have the ability to review a single frame of a video. Further, during the telephonic interview, the Office stated that it would be obvious to include the snapshot function in Mottur because both references concern communicating video. However, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 52143.01(8th ed., rev. 2) citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Here, the Office is stating that the motivation to combine the references is to increase the capabilities of the systems of Mottur (to capture still images because often users like to have the ability to review a single frame of video per page 5 of the Action) as well as enhance the capabilities (to provide snapshots having a superior size and quality compared with the video per page 3 of the Action). However, as acknowledged by the background of Ramasubramanian at col. 2, lines 6+, "screen dumping" to capture frames of the same resolution of video was alleged to be known in the art in 1996 prior to the filing of Mottur. Despite such capabilities existing as of Mottur's filing date, Mottur fails to disclose or teach capturing still images because Mottur is concerned with avoiding choppy video not with capturing still images as set forth at paragraph 0005 of Mottur. Applicant respectfully submits that Mottur is not concerned with obtaining still images.

Assuming arguendo even if such functionality of capturing still images of video were desirable to a user to modify the teachings of Mottur (which Applicants submit is not present), such modifications could include modifications to include still images having the same resolution of the video. The Office further baldly alleges that one would be motivated to make substantial modifications to Mottur to accommodate the capability to provide higher resolution and quality of images with absolutely no evidentiary support to make the extensive revisions. The problems addressed by Ramasubramanian for providing higher quality still images are of no concern to Mottur which is only concerned with controlling a remote camera during playback and for avoiding choppy video. Mottur is not concerned with provision of still images let alone still images of increased quality or resolution over the video content. Without proper evidentiary support as required by Federal Circuit

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precedent, the Office has engaged in inappropriate reliance upon Applicant's disclosure in formulating the 103 rejection. The motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination. *See, e.g., Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). Accordingly, assuming arguendo if there is motivation to modify Mottur, *there is no motivation to further extensively modify Mottur over the capability of screen dumping to capture high resolution photographs.*

In addition, Mottur at paragraph 0005 is concerned with delay between image updates to avoid choppy video. To modify Mottur as alleged in the Action to accommodate high resolution photographs would usurp bandwidth available for seamless communication of video sacrificing video quality to address problems which are of no concern to Mottur and in fact the modification of Mottur proposed by the Office is directly contrary to the teachings of Mottur to avoid choppy broadcasts in fact would comprise the quality of video communications. *Such teaching away is the antithesis of the art's suggesting that the person of ordinary skill go in the claimed direction. Essentially, teaching away from the art is a per se demonstration of lack of obviousness. In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

Applicant respectfully submits the Office has failed to recite proper motivation to combine the reference teachings and claim 26 is allowable for at least this reason.

Further, even if the references are combined, positively recited limitations of the claims are not disclosed nor suggested by the prior art and claim 26 is allowable for this additional reason. More specifically, Ramasubramanian discloses the capture of still images using a previously stored video file per col. 3, lines 55+. The teachings of the prior art even if combined are void of *generating a video of a scene viewed using a photo-video acquisition device comprising a camera in combination with acquiring a high resolution photograph using the video streamed from the photo-video acquisition device as a view finder* as positively recited in claim 26. Positively-recited limitations of claim 26 are not disclosed nor suggested by the prior art and the method of claim 26 is allowable for at least this reason.

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The claims which depend from claim 26 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 30, the Office has failed to recite sufficient motivation to combine the reference teachings and accordingly the Office has failed to provide a proper 103 rejection of claim 30. Applicants respectfully submit claim 30 is allowable for at least this reason.

In addition, even if the references are combined, there is no teaching or suggestion of *generating video using one or more photo-video acquisitions devices comprising cameras, or acquiring a high resolution photograph using the video streamed from the cameras as a view-finder as recited in claim 30*. Positively-recited limitations of claim 30 are not disclosed nor suggested by the prior art and the method of claim 30 is allowable for at least this reason.

The claims which depend from claim 30 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 34, the Office has failed to recite sufficient motivation to combine the reference teachings and accordingly the Office has failed to provide a proper 103 rejection of claim 34. Applicants respectfully submit claim 34 is allowable for at least this reason.

In addition, the combined teachings of the prior art fail to disclose or suggest *capturing live video data of a scene using a camera*, providing *still image data using the captured live video data* and the *still image data having a resolution greater than a resolution of the live video data*. Positively-recited limitations of claim 34 are not disclosed nor suggested by the prior art and the method of claim 34 is allowable for at least this reason.

The amendments made herein now more positively express limitations which were previously inherent in such claim(s), and accordingly are not for the purpose of narrowing and do not effectively narrow the scope of any claim.

Applicant hereby adds new claims 35-43 which are supported at least by Figs. 1-4 and the associated respective teachings of the specification.

Applicants respectfully request allowance of all pending claims.

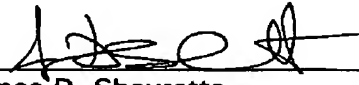
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The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,
Pere Obrador et al.

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